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APPLICATION NO. 08/942,957	FILING DATE 10/02/97	FIRST NAMED INVENTOR NOVOGROD	ATTORNEY DOCKET NO. JCN-001
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MM51/0512

EXAMINER LEE, M
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ART UNIT 2876	PAPER NUMBER
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DATE MAILED: 05/12/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
08/942,957

Applicant(s)  
John C. NOVOGROD

Examiner  
MICHAEL G. LEE

Group Art Unit  
2876



☒ Responsive to communication(s) filed on Apr 28, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-58 is/are pending in the application.

Of the above, claim(s) 1-26 and 30-55 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 27-29 and 56-58 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). herewith

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

1. Receipt is acknowledged of the Response to Election of Species Requirement filed 28 April 1999.

*Election/Restriction*

2. Applicant's election without traverse of Group I, figures 2-8, and claims 1-8, 23-29, 30-37, and 52-58, in Paper No. 4 is acknowledged. However, upon further consideration, claims 1-8, 23-26, 30-37, and 52-55 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention due to the fact that claims 1-8, 23-26, 30-37, and 52-55 are drawn to a specific **fixed-location** negotiable instrument dispenser which communicates to the bank computer via communication network, etc. Accordingly, claims 27-29 and 56-58 which are directed to a specific structural limitation of a **portable hand-held negotiable instrument dispenser** (of Group I) will be examined in this instant application.

*Drawings*

3. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

*Specification*

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 27-29 drawn to an apparatus, and method claims 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foudos (US 4,053,735, cited by the Applicant) in view of Gutman et al (US 5,221,838).

Foudos teach a portable hand held dispenser 20 which dispenses a negotiable instrument 36 comprising a hardwired means [34, 78, 88] for communicating with a remote bank center; a microprocessor 74; a printer 84; a battery 72; a dispenser body 24; a keyboard/keypad 26; and an external device interface 34 (see figs. 1-2; col. 5, lines 20+; and col. 6, lines 13-64).

Although, Foudos teaches a hardwired means for communicating with a remote bank center (see col. 6, lines 22-64), he fails to specifically teach or fairly suggest a radio frequency

Serial Number: 08/942,957  
Art Unit: 2876

Applicant(s): John C. NOVOGROD (235,379)  
Representative: Matthew T. Byrne (40,934)

Page 4

(RF) transceiver within the dispenser as a wireless communication link means to the bank center.

Gutman et al teaches a portable hand held electronic wallet comprising a RF transceiver [202, 203, 204, 220, 226] and a hardwired means [230, 232] for communicating with a remote bank center (see figs. 2A-2B and 5A-5E). In view of Gutman et al's teaching, it would have been obvious to one ordinary skill in the art at the time the invention was made to employ the RF transceiver to the teachings of Foudos in addition to his hardwired communication means as an alternative means for communicating with the remote bank center. Moreover, the modified system of Foudos as modified by Gutman et al would not solely depend on the hardwired communication means (i.e., a phone jack or the like) for communicating with the

remote bank center but rather the portable hand held dispenser can also be carried at a remote site which may or may not have a phone jack or the like and the transaction can be still made. Accordingly, the modification would have been an obvious extension for providing the latest means for communicating between two remote sites.

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Hennessy et al (US 4,390,968), Garvin (US 4,355,369), Kreidich (US 3,183,829), and Gorgens (US 4,234,932) discloses a remote transaction devices/system.

Serial Number: 08/942,957

Art Unit: 2876

Applicant(s): John C. NOVOGROD (235,379)

Page 5

Representative: Matthew T. Byrne (40,934)


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Michael G. Lee* whose telephone number is (703) 305-3503. The examiner can normally be reached between the hours of 6:30AM to 4:00PM Monday thru Thursday and every other Friday (first Friday of the bi-week).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald T. Hajec, can be reached on (703) 308-4075. The fax phone number for this Group is (703)308-5841 or (703) 308-7722.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [michael.lee@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

  
**MICHAEL G. LEE**  
Primary Examiner  
MAY 07, 1999

Attachment 5

The drawings submitted with this application were declared informal by the applicant. Accordingly they have not been reviewed by a draftsman at this time. When formal drawings are submitted, the draftsman will perform a review.

Direct any inquiries concerning drawing review to the Drawing Review Branch (703) 305-8404.